

C. **REMARKS.**

Applicant has cancelled claims 2, 3, 7 and 8; amended claims 1 and 6; and added claims 10-15.

The Examiner has rejected claims 1, 3-6, 8 and 9 under 35 U.S.C. § 102(b) as being anticipated by U.S. Pat. No. 5,722,120 to Bindschatel et al. The Examiner has also rejected claims 1 and 3 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 5,460,087 to Ogorzalek. The Examiner has further rejected claims 2 and 4-9 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 5,460,087 to Ogorzalek, and further in view of U.S. Pat. No. 6,312,872 to Murphy et al. Finally, the Examiner has rejected claims 2 and 7 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 5,722,120 to Bindschatel et al. in view of U.S. Pat. No. 6,312,872 to Murphy et al.

Applicant has amended claim 1 and claim 6 to include the following limitations:

- said mask is configured to be selectively and continuously dispensable in a generally longitudinal direction along the working surface, and to be removably, affixedly adhered along a predetermined distance of the working surface, said predetermined distance along the working surface being one of a portion of the working surface or the entire working surface such that said image can be transferred to the working surface along the entire predetermined distance without having to reposition the mask; and
- said images that are transferred to the working surface can be positive images of the mask, negative images of the mask, or both positive and negative images of the mask.

Support for first of the above limitations is found in the specification at, for example, pg. 4, lines 11-20; pg. 5, lines 2-4; pg. 8, lines 18-21; pg. 9, lines 1-11. Support for the second of the above limitations is found in the specification at, for example, pg. 10, lines 1-14.

Applicant has amended Claims 1 and 6 to include limitations that (a) the mask is affixed along a predetermined distance of the working surface, the predetermined surface being a portion

of the working surface or alternatively the entire working surface; and (b) that the images transferred to the working surface can include both positive and negative images of the mask.

None of the references cited by the Examiner, whether alone or combined with one another, teach or suggest the novel aspects of the present invention. Importantly, all of the references cited by the Examiner relate to stencil or masking devices that cover discrete portions of a surface to be painted. Such stencils and masks have been used for decades if not centuries, but not one of these devices has the claimed attributes of the present invention, *i.e.*, the ability to continuously and selectively dispensed along an entire working surface such as a wall.

§ 102(b) Rejections

Specifically, the Examiner argues that the Bindschatel '120 patent teaches a mask that is configured to be selectively dispensable to cover an entire portion of a door. Applicant respectfully submits that Bindschatel is directed not to a mask that is selectively dispensable to cover an entire portion of a door. Rather, Bindschatel is expressly directed to a pre-stamped half-hinge cover to protect a **half hinge** from overspray during door finishing (see, e.g., figs 1-2). Bindschatel is not directed to a continuous mask device, rather it is directed to a series of pre-cut hinge covers. Bindschatel is not capable of being dispensed to continuously cover a working surface for the purpose of applying positive and negative images to the working surface.

Moreover, Bindschatel does not teach covering a predetermined distance along the working surface which is one of a portion of the working surface or the entire working surface, without repeated application of the mask. It merely teaches covering an entire half-hinge of a door to protect the half-hinge from overspray.

§ 103 Rejections

As indicated previously, the Examiner has also indicated that claims 1 and 3 are obvious in light of U.S. Pat. No. 5,460,087 to Ogorzalek, and that claims 2 and 4-9 are obvious in light of U.S. Pat. No. 5,460,087 to Ogorzalek, and further in view of U.S. Pat. No. 6,312,872 to Murphy et al.

To prove a *prima facie* case of obviousness the Examiner must provide: (1) one or more references; (2) that were available to the inventor; and (3) that teach; (4) a suggestion to combine or modify the references; (5) the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art. See Donner, Ira H., Patent Prosecution, p. 357 (1996) (citing In re Rinehart, 531 F.2d 1048, 189 U.S.P.Q. 143 (C.C.P.A. 1976) and In re Litner, 458 F.2d 1013, 173 U.S.P.Q. 560 (C.C.P.A. 1972)).

The Ogorzalek '087 patent is directed to a stencil devices that requires repeated application of the stencil device, *i.e.*, it must be repositioned in order to apply an image along the length of a working surface. Ogorzalek does not teach a masking device which is affixedly adhered to a predetermined distance along the working surface with a single, continuous length of said mask, said predetermined distance along the working surface being one of a portion of the working surface or the entire working surface without repeated application of the mask. Similarly, Ogorzalek does not teach a masking device which transfers both positive and negative images of the mask to the working surface.

The Murphy '872 is not even a masking device. Rather, it is directed to a relief image printing plate. As such, the invention of the Murphy '872 is not removably adhered to an entire portion of the working surface along the length of the working surface. Like the other references

cited by the Examiner, Murphy does not teach a masking device which is affixedly adhered to a predetermined distance along the working surface with a single, continuous length of said mask, said predetermined distance along the working surface being one of a portion of the working surface or the entire working surface, without repeated application of the mask. Similarly, Murphy does not teach a masking device which transfers both positive and negative images of the mask to the working surface.

None of the references cited by the Examiner (whether alone or in combination) are sufficient to have made applicants claimed invention obvious to one of ordinary skill in the art. Applicant's claimed invention, as amended, includes limitations directed to a mask which is affixed along a predetermined distance of a working surface. The predetermined surface being a portion of the working surface or the entire working surface, and that the images transferred to the working surface can include both positive and negative images of the mask, or both. Applicant respectfully submits that its claims, as amended, have overcome the Examiner's objections.

Claims 1 and 6 have been amended to more clearly recite Applicant's claimed invention. All of the remaining claims depend either from claim 1 or claim 6. None of the cited references, whether alone or combined, teach or suggest applicant claimed invention including the limitations that (a) the mask is affixed along a predetermined distance of the working surface, the predetermined surface being a portion of the working surface or alternatively the entire working surface, without repeated application of the mask and (b) that the images transferred to the working surface include both positive and negative images of the mask. Applicant has added new claims 10-15. No new matter is added by such claims.

Accordingly, Applicant respectfully submits that its claimed invention, as amended, has overcome the Examiner's objections.

C. CONCLUSION

In view of the foregoing Amendment and Remarks, Applicant requests that the Examiner withdraw all objections and place this Application in condition for allowance.

Respectfully submitted,

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1. (Twice Amended) A masking apparatus for transferring ~~an image~~images to a working surface, comprising:

(a) a mask formed from a unitary and continuous substrate, the mask having an outer surface and an inner surface; said inner surface having an adhesive disposed thereon;

(b) a backing removably affixed to said mask at said inner surface;

(c) a plurality of designs formed in said mask;

(d) said mask adapted to be removably attached to said working surface at said inner surface; ~~and~~

(e) wherein said mask is configured to be selectively and continuously dispensable in a generally longitudinal direction along the working surface ~~to continuously cover, and to be removably~~ affixedly adhered ~~to an entire longitudinal~~along a predetermined distance of the working surface, said predetermined distance along the working surface being one of a portion of the working surface ~~where the image is to be transferred regardless of the length of such or the entire~~ working surface such that the apparatus does not have to be repeatedly applied after each use to achieve the image transfer along the working surface ~~said image can be transferred to the working surface along the entire predetermined distance without having to reposition the mask; and~~

(f) wherein said images that are transferred to the working surface can be positive images of the mask, negative images of the mask, or both positive and negative images of the mask.

Please amend Claim 6 to read as follows:

6. (Twice Amended) A masking apparatus for transferring an image to a working surface, comprising:

(a) a mask formed from a unitary and continuous substrate, the mask having an outer surface and an inner surface; said inner surface having an adhesive disposed thereon and a backing removably affixed to said mask at said inner surface;

(b) said mask having a plurality of precut designs; said designs generally repeat along at least a portion of said mask to form a design pattern; {and}

(c) said mask adapted to be removably attached to said working surface at said inner surface;

(d) wherein said mask is configured to be selectively and continuously dispensable in a generally longitudinal direction along the working surface ~~to continuously cover, and to be removably, affixedly adhered to an entire longitudinal~~ along a predetermined distance of the working surface, said predetermined distance along the working surface being one of a portion of the working surface ~~where or the entire working surface, such that said~~ image ~~is to can~~ be transferred ~~regardless of~~ to the length of such working surface such that the apparatus does not have to be repeatedly applied after each use to achieve the image transfer along the working surface. working surface along the entire predetermined distance without having to reposition the mask; and

(e) wherein said image that is transferred to the working surface can be a positive image of the mask, a negative image of the mask, or both a positive and negative image of the mask.

Please add the following claims:

10. The masking apparatus of claim 1 wherein said mask is initially assembled in a roll.

11. The masking apparatus of claim 1 wherein said substrate is formed from a low tack adhesive paper.

12. The masking apparatus of claim 6 wherein said mask is initially assembled in a roll.

13. The masking apparatus of claim 6 wherein said substrate is formed from a low tack adhesive paper.

14. The masking apparatus of claim 1 wherein said working surface is at least one of a wall, wood, glass, fabric, metal, concrete, terra cotta, plaster, ceramics, stationery, a gift bag, and an envelope.

15. The masking apparatus of claim 6 wherein said working surface is at least one of a wall, wood, glass, fabric, metal, concrete, terra cotta, plaster, ceramics, stationery, a gift bag, and an envelope.

16. The masking apparatus of claim 1 wherein said image is transferred by application of a transfer medium comprising at least one of flat paint, satin paint, matte paint, semi gloss paint, hi gloss paint, interior and exterior paint, acrylic paint, Krylon® spray paint, Delta® perm enamel, Pebeo™ glass paint, fabric paint, fabric marker, fabric crayon, metal paint, outdoor paint, ceramic glaze, ceramic marker, ceramic pen, ceramic paint, candle paint media, oil paint, stamp ink, a marker, embossing powder, a pen, a pencil, chalk, scissors, a razor, or a knife.

17. The masking apparatus of claim 6 wherein said image is transferred to said working surface by application of a transfer medium comprising at least one of flat paint, satin paint, matte paint, semi gloss paint, hi gloss paint, interior and exterior paint, acrylic paint, Krylon® spray paint, Delta® perm enamel, Pebeo™ glass paint, fabric paint, fabric marker, fabric crayon, metal paint, outdoor paint, ceramic glaze, ceramic marker, ceramic pen, ceramic paint, candle paint media, oil paint, stamp ink, a marker, embossing powder, a pen, a pencil, chalk, scissors, a razor, or a knife.